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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,025

12/21/2005

Luis Barriga Caceres

P18155-US1

1351

27045

7590

04/27/2009

ERICSSON INC.
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EXAMINER

PHAM, LUU T

ART UNIT

PAPER NUMBER

2437

MAIL DATE

DELIVERY MODE

04/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/595,025</p>	<p>Applicant(s) CACERES ET AL.</p>	
	<p>Examiner LUU PHAM</p>	<p>Art Unit 2437</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 24-27 and 29-46.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437

/Luu Pham/
Examiner, Art Unit 2437

Applicants' arguments in the Remarks filed on 04/20/2009 have been fully considered but they are not persuasive.

Applicants' arguments:

a) "[C]laims 24-27 and 29-40 are directed to statutory subject matter. Each of those claims is directed to an apparatus wherein certain 'means for' performing each of a novel combination of functions are performed. Not only do the claim preambles limit the claim to an apparatus, but such 'means for' elements are statutorily authorized under § 112, ¶6."

b) "Montenegro thus fails to anticipate two different IP address corresponding to the same entity accompanying the packet and used for different purpose."

c) "Montenegro fails to teach means for establishing a secure tunnel with a user from a Secure Service Entry Point when receiving access credentials through an access network by using an outer IP address assigned to the user by the access network for addressing the user, and by using the internal IP address assigned to identify the user in the service network as an inner IP address in the tunneled traffic."

The Examiner disagrees due to the following reasons:

Per a) As stated in the Office Action mailed on 02/18/2009, claims 24 and 37 are not directed to eligible subject matter in view of *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). Although the preambles of the claims 24 and 37 recite "an apparatus," and "a user equipment," respectively, the bodies of the claims do not positively recite any elements of hardware. The bodies of these claims merely recite "means for receiving," "means for establishing," and "means for assigning," and do not positively recite any element of hardware or machine. There is no further disclosure in the specification as to how the aforementioned "means for" claimed are implemented. Since said aforementioned "means for" could be implemented in software by one of ordinary skill in the art at the time the invention was made; therefore, the nature of the subject matter claimed may reasonably be construed as non-tangible embodiments. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. The claims are also found improper as indefinite because the claims recite "means for" languages and there is no structure disclosed in the specification. "If there is no structure in the specification corresponding to the means-plus-function limitation in the claims, the claims will be found invalid as indefinite." *Biomedino, LLC vs. Waters Technology Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007).

Per b) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "two different IP address corresponding to the same entity accompanying the packet and used for different purpose") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Per c) Jin and Montenegro do disclose establishing a secure tunnel with a user from a Secure Service Entry Point when receiving access credentials through an access network (Jin: col. 2, lines 40-59; col. 5, lines 43-52; the SSG Server is inserted between the NAS and the AAA Server, and its function is to create secure channels to private areas of the network for authorized users) by using an outer IP address assigned to the user by the access network for addressing the user, and by using the internal IP address assigned to identify the user in the service network as an inner IP address in the tunneled traffic (Montenegro: col. 4, lines 20-36; the address MN refers to the address of the mobile node when within the private network; the home agent will pre-pend an additional address of GW; the gateway when receives this packet and strips the added header to recover the original packet which has a source address of CN and destination address of MN; the gateway will recognize that the MN has a 'binding' with a current address of FA).